



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,919	06/25/2003	Yasutaka Tsuru	62758-041	6010

7590 04/09/2007  
McDermott, Will & Emery  
600, 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
----------

JONES, HEATHER RAE

ART UNIT	PAPER NUMBER
----------	--------------

2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,919	<b>Applicant(s)</b> TSURU ET AL.	
	<b>Examiner</b> Heather R. Jones	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                  |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/2003 and 4/20/2006</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities:
  - a. Page 9, line 12: change "decoding unit 13" to --decoding unit 14--.
  - b. Page 9, line 15: change "incorporation unit 13" to --incorporation unit 18.
  - c. Page 11, line 20: change "CM1 and PM2" to --CM1 and PM1--.
  - d. Page 15, line 1: change "Fig. 2B" to --Fig. 3B--.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figs. 1, 9, and 10 – reference character "22".

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

Art Unit: 2621

CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (U.S. Patent Application Publication 2003/0037068) in view of Proehl (U.S. Patent 6,614,844)

Regarding claim 1, Thomas et al. discloses a video recording/playback system for recording and playback of video data received, comprising: storage means (46) for receiving and storing video data which consists of sets of main data and sub data falling under different categories, the sets of main data and sub data being associated and sequenced along a time axis (Fig. 1, paragraphs [0024], [0027], [0030], [0044], and [0073] – television programs (main data) along with advertisements (sub data) are being sent to the system); playback means for reading main data and sub data from the storage means and rendering video contents of these data (Fig. 9, paragraphs [0071] – [0073], and [0078]), and control means that judges whether or not the main data has been paused or fast-

forwarded and follows the media data accordingly (paragraphs [0027]).

However, Thomas et al. fails to disclose a control means which judges whether the sub data has been read from the storage means and its video rendered and, unless the sub data video has been rendered, incorporates substitute data which has been associated in advance with the sub data in the main data, and renders main video accompanied with substitute information.

Referring to the Proehl reference, Proehl discloses a system comprising: playback means for reading main data and sub data and rendering video contents of these data (col. 1, lines 33-53); and control means which judges whether the sub data has been read from the storage means and its video rendered and, unless the sub data video has been rendered, incorporates substitute data which has been associated in advance with the sub data in the main data, and renders main video accompanied with substitute information (col. 2, lines 32-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have not only added special instructions during pause modes to display certain images as disclosed by Thomas et al. but to have added special instructions regarding fast-forwarding that allows the user to display extra information as disclosed by Proehl in the device disclosed by Thomas et al. in order to allow advertisers to still promote their product or service even though their commercial is being fast-forwarded.

Regarding claim 2, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the main data is program data and the sub data is commercial data (Thomas et al.: paragraphs [0024], [0027], [0030], [0044], and [0073] – television programs (main data) along with advertisements (sub data) are being sent to the system; Proehl: Fig. 3; col. 2, lines 61-65; col. 3, lines 1-3).

Regarding claim 3, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1 and 2 including that the main data and the sub data include an ID code with identifies the set of main data and sub data and attribute data and the control means judges by detected ID code and attribute data whether the sub data has been rendered (Proehl: Fig. 2 – header information; col. 2, lines 31-57 – the metadata includes all necessary information regarding the way content is displayed on the screen).

Regarding claim 4, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-3 including that unless sub data with a same ID code is assigned to main data which is being rendered has been read from the storage means and rendered, the control means incorporates substitute data associated in advance with the sub data which has not been rendered into the main data and renders main data accompanied with substitute information (Proehl: Figs. 3B and 3C; col. 3, lines 1-3).

Regarding claim 5, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-4 including that the ID code and the attribute data are embedded in the main data and sub data (Proehl: col. 2, lines 32-57).

Regarding claim 6, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-5 including that the main data includes substitute information rendering limit data for setting a limit to rendering the substitute data (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program).

Regarding claim 7, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that the substitute information rendering limit data is specified so that the substitute information will be rendered in a certain range of frames of the main data associated with the sub data which has not been rendered (Proehl: col. 2, lines 32-57 – the embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim 8, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claims 1-6 including that wherein, as the substitute information rendering limit data, the number of times the substitute information is to be rendered or a time range within which the substitute information is to be rendered are set (Proehl: col. 2, lines 32-57 – the

embedded data is only displayed for a certain time and not throughout the rest of the program; col. 3, lines 16-23 - the metadata includes the instructions on how and when the watermark data is to be displayed).

Regarding claim **9**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the substitute data is embedded in the main data (Proehl: col. 2, lines 51-57).

Regarding claim **10**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the main data includes a substitute data address instead of the substitute data, the substitute data address specifying where the substitute data has been stored in advance on the storage means or another storage means on a network (Thomas et al: paragraph [0025] – media distribution facility and media data database).

Regarding claim **11**, Thomas et al. in view of Proehl discloses all the limitations as previously discussed with respect to claim 1 including that the input of a cancel code for disabling the rendering of the substitute information makes it impossible for the control means to incorporate the substitute data into the main data and render main video accompanied with substitute information (Thomas et al: Figs. 7 and 8; paragraphs [0071] – [0077]).

Regarding claims **12-17**, these are method claims corresponding to the apparatus claims 1-5. Therefore, claims 12-17 are analyzed and rejected as previously discussed with respect to claims 1-5.



Art Unit: 2621

**Conclusion**

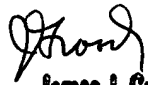
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones  
Examiner  
Art Unit 2621

HRJ  
April 1, 2007

  
James J. Groody  
Supervisory Patent Examiner  
Art Unit 2621 2621